



Rev. 10/93

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

WILLIAM J. BRENNAN ET AL.1

CASE NO.: CI5023 1 US PCT

APPLICATION NO.: 09/155,842

GROUP ART UNIT: 1774

FILED: APRIL 06, 2001

EXAMINER: LAWRENCE, D. FERGUSON

FOR: MULTILAYER CARD

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ARGUMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Reconsideration is respectfully requested of the Office position dated July 16, 2003 which sets forth a rejection of claims 1 to 7 under the provisions of 35 USC 103(a). This Office action represents a third non-final rejection.

No claim has been cancelled or amended in this response since claims 1 to 7 represent a patentable advance in the art.

APPLICANT'S ADVANCE IN THE ART

Prior to a discussion of the inapplicability of the prior art rejection, it may be helpful to review the advance in the art based on the subject matter of the present invention and claim directed thereto.

The present invention is directed to a multilayer card such as employed for identification or credit and particularly adaptable to application of magnetic properties. The objective of the present invention is to improve delamination resistance of the claimed multilayer structure.

Applicants have discovered by use of a copolyesterether in a range of 0.2 to 30% of the total weight of an opaque polyester substrate that delamination resistance is improved with the combination of an ink receptive layer and a cover layer. Again, it is the property of delamination resistance which is critical.

PRIOR ART REJECTION

Claims 1 to 7 stand rejected under 35 USC 103(a) based on the combination of Ito et al. (USP 5,912,085) in view of Sankey, et al. (USP 5,800,911).

The Office rejection discusses the disclosure of both these publications and sets forth the following statement:

Ito and Sankey are analogous art because they are both from the field of multilayered polyester material.

In response to the above quote, it is directly pointed out that the teachings of two publications are not necessarily combinable merely because the publications are in the same field of multilayer polyester material.

The Office rejection sets forth the following conclusion:

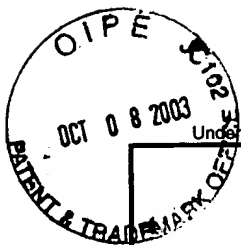
It would have been obvious to one of ordinary skill in the art to include copolyesterether in the polyester substrate of Ito because Sankey teaches the incorporation of copolyesterether helps produce the required deformation index of the material, which is the average thickness percentage of the layer (column 2, lines 14-20 and column 5, lines 38-65).

This conclusion is respectfully submitted to be in error.

Initially, in traversal of the Office position, it is considered the issue is whether one of ordinary skill in the art would modify the layers and composition of Ito based on the disclosure of Sankey.

Sankey is directed to a composite polymeric sheet which is suitable for use as an alternative to metallic foils as a lid for a container. The required properties of such a film are (i) high opacity; (ii) tear resistance; and (iii) embossibility (see column 1, lines 33 to 36). The purpose of incorporation of the copolyesterether is as a softening agent (see column 5, lines 61-67) in order to increase the deformation index of the film, i.e. to improve the embossibility of the film. It is also important to note that the softening agent should be dispersible (column 5, line 61).

Ito is also directed to a multilayer polymeric film but this is where the similarity stops. Ito is directed to a recording sheet suitable for ink-jet printing. The required properties are (i) good water resistance; and (ii) high gloss (see column 1, lines 42 to 44). Clearly, the film of Ito is for an application which is fundamentally different to that of Sankey and, moreover, the required characteristics of the film are fundamentally different. Because there is no overlap whatsoever between the required characteristics of the films of Ito and Sankey, or their intended end-uses, there is no evidence that the skilled person would combine the two documents. There would be no *prima facie* reason for the skilled person to modify the film of Ito in light of the film of Sankey. In particular, there is no reason why the skilled person would wish to improve the embossibility of the films of Ito either by incorporating a copolyesterether or any other material.



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Creation date: 05-25-2004
Indexing Officer: JJI - JUNG-KEUN JI
Team: OIPEBackFileIndexing
Dossier: 09155842

Legal Date: 11-06-2003

No.	Doccode	Number of pages
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Total number of pages: 6

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